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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,834	11/24/2003	Michael Anthony Eastman		4796

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EXAMINER

LUONG, SHIAN TINH NHAN

ART UNIT PAPER NUMBER

3728

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/719,834	EASTMAN, MICHAEL ANTHONY	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shian T. Luong	3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9,12,14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase “said reflective surface is secured within the basin by embedding means toward the center of the depth of said basin against the depth of said reflective surface” and “the securing means...are the compression forces created by the depth of said basin...said reflective surface has a slightly larger diameter than said basin” had no support in the original specification. The specification only disclosed adhering or embedding the reflective surface into the closure cap. The adhesion or the step of embedding does not necessarily require any compression force toward center of the basin. The reflective surface can simply be enclosed firmly into the basin by glue or other means and need not require embedding means toward the center of the depth of the basin. In addition, the specification never disclosed that the reflective surface has a larger diameter than the basin. Clarification is required.

3. Claim 9,12,14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 9, “the reflective surface is secured within said basin toward the center of the depth of said basin”, in claim 12, the phrase “said reflective surface is secured within the

basin by embedding means toward the center of the depth of said basin against the depth of said reflective surface” and in claim 14, “the securing means...are the compression forces created by the depth of said basin...said reflective surface has a slightly larger diameter than said basin is not definite because it is not clear what embedding means or compression forces is exerted toward center of the depth of the basin. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 4 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Speshyock et al. (US 3,211,281). Speshyock et al. discloses a contact lens case comprising a base 1 and a cover 2. At least one reservoir or the receptacle compartment on the top side of the base and having an outer surface. A reflective surface 5 covering for the outer surface of the cover and having a reflective outer surface. The cover has a basin and the reflective surface has a depth less than the basin depth. The depth of the basin is from the top surface of the cover to element 5'. The mirror is the thin piece within the basin as shown in Figure 3.

Applicant argues that the cover in Speshyock et al. does not meet the cover as claimed because the mirrored cover of the instant invention has threads to connect to the base. However, claim 1 does not require this feature as argued. Applicant further argues that the mirrored case holds a contact lens case and is not a mirrored contact lens case by itself. The examiner fully

appreciates the difference pointed out by applicant. However, applicant has not made this differentiation in the claim. The structural language in the claim requires a cap and a base. The cap has a basin and a reflective surface covering on an outer surface. The reflective surface covering has a depth less than the depth of the basin. Speshyock's cover 2 and base 1 have met all of the claim limitations in claim 1. In other words, there is no difference in the claim language between the cover of the applied reference and the claim even with elements 9 in the applied reference.

6. Claim 6 is finally rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Speshyock et al or Speshyock in view of Girard (US 2,650,597) or Ament (US 1,655,452). Speshyock has a basin for receiving the mirror. The mirror appears to be attached to the basin, but in the event that it is not attached, it would have been obvious to secure the mirror to prevent it from inadvertent removal from the basin. Girard and Ament show this type of attachment. Girard teaches providing a mirror on the cap portion with the mirror embedded within a basin. The basin has a depth deeper than the mirror in order to receive the mirror. Ament also teaches a cap 3,4 with a basin that stores a mirror 5 therein. The basin is the area from the top surface to the element 9.

Applicant argues that the examiner has made no effort to cite a suggestion to combine the mirrored caps taught by the secondary references. However, applicant proceeds to state that the examiner alleges that it would be "obvious to secure the mirror to prevent it from inadvertent removal." It is clear from this statement that applicant acknowledges that the examiner did make a suggestion or motivation to combine the references. Hence, the two statements are contrary to one another. In addition, applicant argues that the examiner cannot claim it is obvious to attach

the mirror to the cap because Speshyock may desire removal of the mirror. However, for a rejection based on prima facie case of obviousness, the examiner only has to show some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited reference or prior art specifically suggest making the combination. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In addition, the reference itself does not prohibit the attachment to the basin.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-14 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ulmer et al. (US 3,822,780) in view of Girard and/or Ament.

Ulmer et al. discloses a contact lens case for storing contact lenses comprising a base 18 having a top side. A least one reservoir on the top side of the base and having an outer surface with threads. A cap 14 for the reservoir and is attached to the outer surface of the reservoir by threads. A reflective surface covering 60 is on the outer surface of the cap. Ulmer on column 5, lines 35-38 discussed the adoption of the mirror on a portion of the outside surface of the container but does not disclose how the mirror is formed on the outer surface. However, Girard teaches providing a mirror on a cap portion with the mirror embedded within a basin. The basin has a depth deeper than the mirror in order to receive the mirror. Ament also teaches a cap 3,4

with a basin that stores a mirror 5 therein. The basin is the area from the top surface to the element 9. The mirror is spun or crimped or suitably secured to the cap. Therefore, it would have been obvious in view of Girard and/or Ament to secure the mirror within the basin by any suitable attachment means such by embedding or crimping the mirror therein.

Applicant argues that the examiner has misinterpreted the reference because it is the container 14 that has the mirrored surface, not the cap 18. However, the examiner has interpreted element 14 as the cap and element 18 as the base. It is within the discretion of the examiner to interchange the terms “container” and “cap” as long as the structure fits the term. Hence, the cap 14 has the mirrored surface as required by the claim.

Applicant argues that the examiner cannot claim it is obvious to attach the mirror to the cap because the lack of teaching and Ulmer et al. may desire removal of the mirror. However, for a rejection based on prima facie case of obviousness, the examiner only has to show some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited reference or prior art specifically suggest making the combination. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In addition, the reference itself does not prohibit the attachment to the basin.

9. Claims 1,4,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Meo (Des 358,477) in view of Girard and/or Ament.

D Meo discloses a contact lens case for storing contact lenses comprising a base having a top side. A least one reservoir on the top side of the base and having an outer surface. A cap for the reservoir is attached to the outer surface of the reservoir. De Meo appears to have a reflective surface on the cap. But in the event that De Meo does not have a reflective surface and

a basin, Girard teaches providing a mirror on a cap portion with the mirror embedded within a basin. The basin has a depth deeper than the mirror in order to receive the mirror. The mirror is for application of content. Ament also teaches a cap 3,4 with a basin that stores a mirror 5 therein. The basin is the area from the top surface to the element 9. The mirror is spun or crimped or suitably secured to the cap. Therefore, it would have been obvious in view of Girard and/or Ament to secure the mirror within the cap by any suitable attachment means such by embedding or crimping the mirror therein.

10. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 1 above, further in view of Lin (US )

De Meo does not disclose whether the base and cap are engaged by threads. However, it is conventionally known to engage the cap to the base of a contact lens container by threads. This is shown by Lin as element 102,202.

11. Claims 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Meo (Des 358,477) in view of Girard and/or Ament and Lin

De Meo discloses a contact lens case for storing contact lenses comprising a base having a top side. A least one reservoir on the top side of the base and having an outer surface. A cap for the reservoir is attached to the outer surface of the reservoir. De Meo appears to have a reflective surface on the cap. But in the event that De Meo does not have a reflective surface and a basin, Girard teaches providing a mirror on a cap portion with the mirror embedded within a basin. The basin has a depth deeper than the mirror in order to receive the mirror. The mirror is for application of content. Ament also teaches a cap 3,4 with a basin that stores a mirror 5 therein. The basin is the area from the top surface to the element 9. The mirror is spun or



crimped or suitably secured to the cap. Therefore, it would have been obvious in view of Girard and/or Ament to secure the mirror within the cap by any suitable attachment means such by embedding or crimping the mirror therein.

De Meo does not disclose whether the base and cap are engaged by threads. However, it is conventionally known to engage the cap to the base. This is shown by Lin as element 102,202.

### *Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical

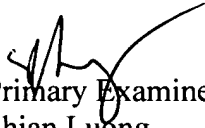
section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Erica Miller at (571) 272-4370.

For applicant's convenience, the official FAX number is 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (571) 272-4557. The examiner can normally be reached on M-H from 7:00am to 4:00pm EST. The examiner's supervisor Mickey Yu can be reached at (571) 272-4562 for urgent matters.

STL  
August 29, 2006

  
Primary Examiner  
Shian Luong  
Art Unit 3728